

Reply to Office Action of August 12, 2003

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of foregoing amendments and the following remarks. Claims 3-37 are pending in the application.

Allowable Subject Matter

Applicant notes with appreciation the indication on page 2 of the Office Action that claims 6-8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicant submits this is not necessary in view of the following remarks.

35 U.S.C. § 102 & 103 Rejections

Claims 4, 9-11, and 21-26 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Felix (U.S. Patent No. 5,946,356, "Felix") in view of Hall (U.S. Patent No. 6,208,871). Claim 3 was rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Felix and Hall as applied to claim 23 and further in view of Applicant's Admitted Prior Art (AAPA). Claim 5 was rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Felix and Hall as applied to claim 24 and further in view of Gilhousen (U.S. Patent No. 6,185,246). Claims 12-20 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable

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over AAPA in view of Gilhousen (U.S. Patent No. 6,185,246). Applicant respectfully traverses each of these rejections for at least the following reasons.

Regarding claims 10, 21 and 24, the Examiner has alleged that Felix teaches “broadcasting information of at least one or more code class in which Walsh codes ...” (Office Action, page 2). However, contrary to the Examiner’s allegations, Felix teaches only to monitor the Forward Common Control Channel (Paging Channel) before channel allocation and notifies the pending data transmission to the mobile station and spreading codes used by the Fundamental Channel and Supplemental Channel (SCH) and assigned data rate of the SCH. However, these actions are performed after the access of the mobile station is finished. Further, Felix does not teach broadcasting “state information of at least one or more code classes in which Walsh codes”, such as recited in claim 10. In contrast to Felix, claim 10 recites broadcasting the state (e.g., idle/busy) information on a paging channel or broadcast channel.

Still further, the Office Action proposes combining Felix in view of Hall to allegedly render independent claims 10, 21 and 24 obvious. However, Applicant respectfully submits that the combination of Felix and Hall fails to teach the features of Applicant’s claimed combinations as alleged. For example regarding claim 10, the Office Action admits that Felix fails to disclose or suggest “broadcasting at a base station call access control signal including interference information of a reverse link” (see page 3, lines 3-5 of the Office Action dated August 12, 2003). However, the Office Action alleges that Hall teaches this feature and that it would be obvious

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for one of ordinary skill in the art to combine these references to arrive at Applicant's claimed combinations. Applicant respectfully disagrees with both these assertions.

Regarding the teachings of Hall, the Office Action relies on column 2, lines 2-7 as teaching broadcasting from a base station a call access control signal including interference information of a reverse link to a plurality of mobile stations. However, in contrast to the interpretation of the Hall reference in the Office Action, Hall specifically teaches that the information is transmitted from a plurality of base stations to the mobile station under control of the mobile station. Hall specifically discloses the following in column 2, lines 2-7 (with emphasis added).

CDMA MAHOs are generally **initiated by the mobile station** based upon measurements of local pilot signals emanating from **neighboring BTS sectors** and/or BTSs, wherein each pilot signal includes a signal strength measurement E_c/I_o (Energy per chip divided by total interference), and an associated short code PN time offset.

As clearly indicated in the foregoing section of Hall, the mobile station receives broadcasts from a plurality of base stations to facilitate a mobile assisted handoff (MAHO). Accordingly, Applicant respectfully submits that Hall does not teach or suggest broadcasting from a base station a call access control signal including interference information of a reverse link to a plurality of mobile stations, as alleged. Further, Hall is related to the measurement of pilot signals to measure the E/I for the MAHO and does not teach "call access control signal including interference information of a reverse link", such as recited in claim 10 of Applicant's

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claimed combinations.

As stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Neither Felix, Hall nor the combination of these references discloses the features of Applicant's claimed combinations as noted above. Therefore, these references do not render Applicant's claimed combinations obvious as alleged by the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Further, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the Office Action has failed to show motivation to combine. For example, Applicant respectfully submits that one of ordinary skill in the art would not look to a mobile assisted handoff process

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where the mobile handset is expressly in control of the process to combine with a base station controlled broadband communication system of Felix.

Regarding claim 12, Applicant respectfully submits that Gilhousen fails to teach or suggest any field representing the state of Walsh code classes. In contrast, Gilhousen merely shows searching available codes with separate assigned list and busy list having each possible Walsh code among the used codes in the table of Walsh codes. The busy list is then updated based on the assigned list. The list is queried and a code is assigned. Accordingly, there is no teaching or suggestion to generate the field representing the state of the Walsh code classes in Gilhousen.

Further, Applicant respectfully submits that the Office Action has provided no motivation for the alleged combination of the AAPA and Gilhousen, as noted in the prior response. However, even if combined, Applicant submits that Gilhousen in combination with the alleged AAPA discussed in the specification, fails to teach or suggest at least the features of transmitting call access control information without receiving a specific request for the same from a mobile station (e.g., a call access request). Specifically, the Examiner cites column 18, lines 9-12 of Gilhousen, which discloses the following (with emphasis added). “The function select, and data rate select signals are transmitted to the mobile unit by the cell-site **as part of the call set up message.**” Clearly, Gilhousen fails to teach or suggest repeatedly, or periodically transmitting call access control information regarding at least availability of Walsh

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codes or status information prior to/or without receiving a call access request.

Regarding claims 13 and 19, the Office Action alleges Official Notice of the alleged modifications to the AAPA and Gilhousen to render these claims obvious. Applicant has already rebutted the allegation that the AAPA and Gilhousen renders the base claims obvious. Further, Applicant traverses this rejection because there is no support in the record for the conclusion that the identified features are "old and well known." In accordance with MPEP § 2144.03, the Examiner must cite a reference in support of his position.

Further, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the systems of the AAPA and Gilhousen to arrive at Applicant's claimed combinations absent impermissible hindsight reference to Applicant's specification.

The remaining independent claims (i.e., claims 15, 21, 24 and 33) recite related subject matter to the above-identified independent claims, and are therefore allowable for reasons similar to those given above.

The dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination. Further, new claims 27-32 recite similar subject matter to claims 6-8 and should be allowable at least for similar reasons.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the

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outstanding rejections to claims 3-5, and 9-26 and allowance of claims 3-37.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Mark E. Olds at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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